

REMARKS

Claims 11-25 are pending in this application. None of the claims have been amended in this response. Favorable reconsideration is respectfully requested.

Claims 11-13 and 16-19 of the present application were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over *Zicker* (US Patent No. 5,887,259) in view of *Alperovich* (US Patent 6,233,448).

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Zicker* (US Patent No. 5,887,259) in view of *Alperovich* (US Patent 6,233,448) and further in view of *Takemura* (EP 0830046).

Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Zicker* (US Patent No. 5,887,259) in view of *Alperovich* (US Patent 6,233,448) and further in view of *Takemura* (EP 0830046) and further in view of *Davis et al.* (US Patent 6,314,519).

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Zicker* (US Patent No. 5,887,259) in view of *Alperovich* (US Patent 6,233,448) and further in view of *Oura* (US Patent 5,991,614). Applicants respectfully traverse these rejections.

Specifically, the cited art, alone or in combination, does not teach the feature of a “locally emitting transmitter . . . being part of a pico-cell mobile radio network separate from the public cellular mobile radio network”, wherein the locally emitting transmitter activates/deactivates mobile stations as recited in claim 11, and similarly recited in claims 17 and 19. The present claims recite a configuration for adapting a mobile phone for communication over a cellular radio network, as well as a pico-cell radio network. Under the recited configuration, different radio networks may be supported, in which the pico-cell network cooperates with the public switch telephone network to avoid additional traffic on the cellular radio network in cases where the pico-cell network is available.

In contrast, *Zicker* is completely silent on the activation or deactivation of a communication device from a distant unit as is recited in the present claims. The Office Action seems to equate administration messages between the mobile communication device and the two networks in case of handshaking in *Zicker* with the deactivating message in claim 11. However, the administration messages in *Zicker* have no influence on the allowed/activated functions of

the mobile communication device, and are only related to the initiation of a communication line (col. 4, lines 28-61).

Regarding Alperovich, this document also does not solve the deficiencies of Zicker, discussed above. Alperovich simply teaches an alternative method to support a deactivation of a mobile communication device (see Abstract), where a deactivation of the mobile communication device is initiated by the device itself being adapted to compare actual local data with reference local data representing regions with and without allowed activated mobile communication device. As such, the teaching of Alperovich is based on the device itself and additionally requires a tremendous amount of local data to prevent the device from being active in forbidden regions.

Furthermore, Applicant submits that there is no teaching, suggestion or motivation for one having ordinary skill in the art to combine *Zicker* with *Alperovich* in the manner suggested in the Office Action. The Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). In making this determination, the question is not whether the differences between the prior art and the claims themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983)(emphasis added). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Zicker relies on a unique control protocol within a framework of overlay cells that operate independently of the radiotelephone network (see Abstract), which is a completely different configuration from that disclosed in Alperovich. There is no teaching, suggestion or motivation for one having ordinary skill in the art to combine the references in the manner suggested in the Office Action.

In light of the above, Applicant respectfully submits that claims 11-25 of the present application, and all claims that depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-0644) on the account statement.

Respectfully submitted,

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